

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARLTON WHITEFORD

Appeal No. 2001-1504
Application 08/618,263

ON BRIEF

Before ABRAMS, MCQUADE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Carlton Whiteford appeals from the final rejection (Paper No. 19) of claims 16, 19 and 20. Claims 1 through 15 and 18 stand allowed, and claim 17, the only other claim pending in the application, stands objected to as depending from a rejected base claim.

THE INVENTION

Appeal No. 2001-1504
Application 08/618,263

The invention relates "generally to plier-type tools and, more particularly, to a tool of this type which includes a pair of coacting wedges for automatically adjusting the tool proportionally to the size of a work piece engaged by its jaws" (specification, page 1). Claim 16, from which claims 19 and 20 depend, recites such a tool comprising, inter alia, a stationary jaw and a movable jaw, each having a laminated construction. A copy of claims 16, 19 and 20 appears in the appendix to the appellant's main brief (Paper No. 22).

THE EVIDENCE

The items relied on by the examiner as evidence of obviousness are:

Emmett	2,618,188	Nov. 18, 1952
Lance	4,297,756	Nov. 3, 1981
Warheit	4,802,390	Feb. 7, 1989

The item relied on by the appellant as evidence of non-obviousness is:

The 37 CFR § 1.132 Declaration of Robert D. Wooster, Jr., filed with appended Exhibits 1 and 2 on August 20, 1999 (part of Paper No. 18)

THE REJECTIONS

Appeal No. 2001-1504
Application 08/618,263

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lance in view of Emmett.

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lance in view of Emmett and Warheit.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 22 and 25) and to the examiner's final rejection and answer (Paper Nos. 19 and 23) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

DISCUSSION

I. Grouping of claims

On page 6 in the main brief, the appellant states that "appealed claims 16, 19 and 20 can be grouped into a single Group 'A' with independent claim 16 representative of the Group." In accordance with this grouping, and for purposes of this appeal, claims 19 and 20 shall stand or fall with representative claim 16.

II. The merits

Lance, the examiner's primary reference, discloses a self-adjusting locking wrench tool 100 (see Figures 16 and 17) having a stationary jaw and a movable jaw. As best shown in the partially cutaway side view illustrated in Figure 16, the stationary jaw defines a recess which receives a flat portion of the movable jaw.

With implied reference to tool 100, the examiner (see page 3 in the answer) has determined that Lance teaches or would have

suggested all of the limitations in claim 16 except for those pertaining to the laminated construction of the stationary and movable jaws. This determination is reasonable on its face and has not been disputed by the appellant.

Emmett discloses a slidable jaw wrench wherein each of jaws J and J' has a laminated construction (see column 2, lines 11 through 32).

In proposing to combine Lance and Emmett to reject claim 16, the examiner concludes that it would have been obvious to one of ordinary skill in the art "to form the jaws of Lance as laminated with a recess between the outer laminae of the fixed

jaw receiving a portion of the inner laminae of the movable jaw for strength and stability as taught by Emmett" (answer, page 3).

To reject a claim, an examiner bears the initial burden of presenting a factual basis establishing a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1990); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If this burden is met, the burden of coming forward with a showing of facts supporting the opposite conclusion shifts to the applicant. After such rebuttal evidence is submitted, all of the evidence must be considered anew, with patentability being determined on the

totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. Of course, if the examiner's initial showing does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. Id.

In the present case, the appellant does not challenge, and in fact seems to acquiesce to (see page 11 in the main

brief), the examiner's determination that a person of ordinary skill in the art would have appreciated the laminated jaw structure disclosed by Emmett as affording strength and stability. On its face, this appreciation would have furnished such a person with the requisite motivation or suggestion to make Lance's jaws of a laminated construction. As accurately noted by the appellant (see page 10 in the main brief), neither Lance nor Emmett meets the limitations in claim 16 requiring a recess defined by the outer laminae of the stationary jaw and a flat portion defined by the inner laminae of the movable jaw. The test for obviousness, however, is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In other words, non-obviousness cannot be established by attacking references individually where the rejection is based

upon the teachings of a combination of references. In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Given Lance's disclosure of a recess in the stationary jaw for receiving a flat portion of the movable jaw, the proposed modification of Lance in view of Emmett would result in the laminated recess/flat portion arrangement required by claim 16. Hence, the combined teachings of Lance and Emmett establish a prima facie case of obviousness with respect to the subject matter recited in claim 16. As the appellant has advanced the Wooster declaration in rebuttal, the next step is to consider all of this evidence anew.

In essence, the appellant proffers the Wooster declaration to show that the subject matter recited in the appealed claims would not have been obvious within the meaning of § 103(a) because it 1) addresses a problem not contemplated by the prior art, 2) solves a long felt need in the art and 3) has enjoyed a significant degree of commercial success.

With regard to the first point, the declaration states in pertinent part that

[t]he laminated jaw construction set forth in pending claim 16 is integral to the functional mechanism of the self locking tool of the present invention. The self adjusting locking tools of the present invention rely on a pair of coacting wedges for adjusting the tool proportionally to the size of a work piece engaged by the jaws. In order for this wedge action to properly work it is necessary for each of the pivot points associated with the jaws to be totally free. In order to ensure the pivot points can freely work, and thereby permit the self locking mechanism to properly function, it is critical to provide clearances in all of the pivot points. The clearances provided directly result from the construction of the jaws. The laminated construction of the jaws set forth in the pending claim 16 permits the jaws to be constructed to tolerances that heretofore were not readily obtainable from prior art forging and stamping processes and enables consistent operation of the self-adjusting locking features of the present invention.

13. While the Emmett and Warheit patents disclose laminated constructions, the laminated construction in the tools of the Emmett and Warheit patents does not provide nor, in my opinion, suggest the functional advantages of using a laminated jaw construction for a self-adjusting locking tool. The use of a laminated construction in the tools of the Emmett and Warheit patents increases the strength of the tool and reduces the cost of production. The use of a laminated construction in those tools, however, is not, as it is in the present invention, integral to the functional mechanism of the tool.

14. Thus, the laminated construction of the jaws in the self-adjusting locking tool of the present invention, provides a functional and mechanical result not present in the laminated tool construction in the Emmett and Warheit patents. Further, in my opinion, the operational advantages obtained by the laminated construction of pending claim 16, and in particular the

enhanced operation of the wedges, pivot points, and jaws of the self-adjusting locking tool of the present invention, would not have been obvious to one of ordinary skill in the tool art at the time the present invention was made [Wooster declaration, paragraphs 12 through 14].

The foregoing makes clear that the noted functional or operational advantages result from allegedly critical pivot point clearances or tolerances, not from the laminated jaw construction itself. Claim 16, however, does not recite such pivot point clearances or tolerances,¹ and thus is not commensurate with the asserted advantages. Emmett establishes that laminated jaw constructions are conventional expedients, and Wooster's statement that such a construction "increases the strength of the tool and reduces the cost of production" (paragraph 13) buttresses the examiner's conclusion that it would have been obvious to form Lance's jaws of laminated construction for the purposes of strength and stability. The law does not require that references be combined for the reasons contemplated by the inventor as long as some

¹ Given the lack of any mention of these pivot point clearances or tolerances in the appellant's disclosure, it would seem that claim 16 could not recite same without raising 35 U.S.C. § 112, first paragraph, issues.

Appeal No. 2001-1504
Application 08/618,263

motivation or suggestion to combine them is provided by the prior art taken as a whole. In re Beattie,

974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

The advantages noted by the examiner and confirmed by Wooster would have provided the necessary motivation or suggestion to combine Lance and Emmett in the manner proposed. Moreover, there is nothing in the record showing that at the time the invention was made the inventor was even aware of the operational or functional advantages described by Wooster.

The Wooster declaration also falls short of demonstrating that the subject matter on appeal solved a long felt need in the art.

To establish a long felt need, an applicant must demonstrate the existence of a problem which has been recognized in the art and has remained unsolved over a long period of time. See Vandenberg v. Dairy Equipment Co., 740 F.2d 1560, 224 USPQ 195 (Fed. Cir. 1984). The applicant must further show that the invention satisfies the long felt need. See In re Cavanagh, 436 F.2d 491, 496, 168 USPQ 466, 471 (CCPA 1971). Along these lines, the Wooster declaration (see

paragraphs 7 through 9 and Exhibit 1) merely contains an unsubstantiated assertion that production of certain prior art self-adjusting tools which did not have laminated jaw constructions was terminated "reportedly because of manufacturing difficulties" (paragraph 8). This assertion

mirrors the one made on page 2 in the appellant's specification. Wooster, however, neither identifies the alleged manufacturing difficulties nor avers that the subject matter recited in claim 16 solves these problems.

Furthermore, even if it is assumed for the sake of argument that these manufacturing difficulties involved an inability to consistently provide the allegedly critical pivot point clearances or tolerances described by Wooster, claim 16 does not recite these clearances/tolerances as part of the claimed tool, and thus is not be commensurate in scope with the apparent solution.

The Wooster declaration likewise has little probative value as evidence of commercial success. For the most part, the appellants' showing in this regard (see declaration paragraph 11) consists of bald sales figures which have not

been placed in any meaningful context which might demonstrate, for example, a substantial share of the market or a profitability per unit which is out of the ordinary. Such bald sales figures constitute minimal, if any, evidence of commercial success. See In re Huang, 100 F.3d 135, 137, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); Cable Elec. Prods. Inc. v. Genmark, Inc., 770 F.2d 1015, 1026-27, 226 USPQ 881, 887-88 (Fed. Cir. 1985). Moreover, any demonstrated commercial success is relevant in the obviousness context only if there is proof that the sales were a direct result of the unique characteristics of the claimed invention. Id. The appellant's attempt to establish such a nexus (see declaration paragraphs 12 through 16 and Exhibit 2) rests on Wooster's unsupported contention the above noted sales figures are attributable to the functional or operational advantages purportedly afforded by the laminated jaw construction recited in claim 16. The promotional literature included in Exhibit 2 simply does not support this assertion. To the extent that the laminated jaw construction is mentioned in this literature (see the article from the December 1997 edition of Motorcyclist), it is touted for its strength, not any

functional or operational advantage. This constitutes yet more support for the rationale underlying the examiner's proposed combination of Lance and Emmett.

In light of the foregoing, the Wooster declaration carries little weight as evidence of non-obviousness, and indeed seems more supportive of the examiner's position than the appellant's. In any event, to the extent that the declaration does constitute evidence of non-obviousness, it clearly is outweighed by the examiner's reference evidence of obviousness. In this regard,

the mere existence of evidence of non-obviousness does not control the obviousness determination. See Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988), cert. denied, 493 U.S. 814 (1989); Richardson-Vicks Inc. v. Upjohn Co., 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997).

Having duly considered the totality of evidence and argument before us, we are satisfied that such justifies the examiner's conclusion that the differences between the subject

Appeal No. 2001-1504
Application 08/618,263

matter recited in claim 16 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejections of claim 16 and claims 19 and 20 which depend therefrom.

SUMMARY

The decision of the examiner to reject claims 16, 19 and 20 is affirmed.

AFFIRMED

Appeal No. 2001-1504
Application 08/618,263

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
)	
)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

JPM/kis
JOHN L. ALEX
COOK, ALEX, MCFARRON, MANZO
CUMMINGS & MEHLER, LTD